

REMARKS

Status of the Claims

Claim 36 is amended herein to include the limitations of dependent claim 38, which has been canceled. Claims 24-37 and 39-42 are currently in the case.

Rejections Under §112

The term "about" as used in claims 24, 35 and 37 is not indefinite.

Applicants continue to traverse the rejection of claims 24, 35 and 37 as indefinite for use of the term "about." It is well established in patent law that the use of flexible terms such as about does not necessarily render a claim indefinite as long as one of skill in the art would be reasonably apprised of the scope of the claim. Applicants assert that one of skill in the art would easily determine the scope of the present claims. For example, the skilled artisan would be able to read a thermometer and determine with reasonable certainty whether an oven or a solution is heating to a temperature of "from about 100° C to about 240° C" or up to about 55°C. The same artisan could look at a clock or watch to determine whether a time period is about 15 minutes, and could read a graduated cylinder or flask to determine the concentration of a solution as from about 50% to about 95% ethanol, as recited in claims 24 and 37. The same is true for the temperatures cited in claim 35. There is therefore, no indefiniteness in the claims.

The Action provides no reasonable explanation for its conclusory statement that the claims are indefinite for using the term "about." The Examiner's attention is drawn to MPEP 2173.05(b) A. in which "about " is found to be definite in each case except in *Amgen v. Chugai* 927 F.2d 1200, 18 USPQ2d 1016 (Fed. Cir. 1991). The Amgen case is distinguished from the present application, because it is a biotech case and thus the measurement of specific activity of

the protein in the claims was inherently imprecise. The case is further distinguished because the claim was amended to include the limitation "at least about 160,000" in order to overcome close prior art.

The district court found that "bioassays provide an imprecise form of measurement with a range of error" and that use of the term "about" 160,000 IU/AU, coupled with the range of error already inherent in the specific activity limitation, served neither to distinguish the invention over the close prior art (which described preparations of 120,000 IU/AU), nor to permit one to know what specific activity values below 160,000, if any, might constitute infringement. 13 USPQ2d at 1787. It found evidence of ambiguity in the fact that Chugai, GI's partner, itself questioned whether the specific activity value of 138,000 IU/AU for its own rEPO was within the claim coverage. *Amgen* at 1030

The Court explicitly stated in the *Amgen* case that this finding did not preclude the use of "about" in claims.

In arriving at this conclusion, we caution that our holding that the term "about" renders indefinite claims 4 and 6 should not be understood as ruling out any and all uses of this term in patent claims. It may be acceptable in appropriate fact situations, e.g., *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1557, 220 USPQ 303, 316 (Fed. Cir. 1983) ("use of 'stretching ... at a rate exceeding about 10% per second' in the claims is not indefinite"), even though it is not here. *Id* at 1031

The Federal Circuit has thus stated that an indefiniteness rejection because of the use of the term about is a special case and is not generally applicable. Because there is no close prior art in the present case, and further because the measurements of time, temperature and concentration required by the claims are not inherently imprecise, the finding in the *Amgen* case are not relevant to the present rejection.

The present claims merely encompass measurements of temperature, time, and concentration which are all straight-forward measurements that are routine in the art. There is no

reason to believe that one of skill in the art would not be able to understand the scope of the claims, and none has been presented in the Action.

Applicants traverse the Examiner's statement that "of the order of" and "substantially" are variations or synonyms of about. Applicants further direct the Examiner to MPEP 2173.05(b) D. in which cases are discussed holding the term "substantially" to be definite, and which contradicts the Action's position.

Because the Examiner has not offered any explanation of why the term "about" renders the claims indefinite, Applicants respectfully request that the rejection be withdrawn.

The term "partially aged beverage" in the preambles of claims 24 and 36 does not render those claims indefinite.

The Action rejects claims 24 and 36 for use of the term "partially aged beverage." Applicants respectfully traverse in part because determination of whether a beverage is fully aged or not is not necessary for the practice of the invention. Claims 24 and 36 are each claims to apparatus for aging beverages. Whether one is using the apparatus for an unaged or a partially aged beverage does not change the structure of the apparatus, and thus does not change the scope of the claims.

One skilled in the relevant art would understand that the invention recited in the claims is not limited to any particular degree of aging of a beverage placed in the apparatus, as long as the material elements of the apparatus are in use.

Applicant submits that this rejection is exactly analogous to a previous rejection by the same Examiner in a commonly owned application in which method claims were rejected as indefinite for use of the term "matured beverage." In overturning that rejection, the Board of Patent Appeals and Interferences stated "From this disclosure and the express terms of the

claims, it is our judgment that one skilled in the relevant art would understand that the invention recited in the appealed claims is not limited to any particular degree of maturation, provided that the material steps of the process are carried out." *Ex Parte Remy F. Gross II, John P. Delmore, and Walter E. Buske*, Appeal No. 2002-2029, Application No. 09/440,037

One of skill would thus understand that the claim is not limited to any particular level of partial aging. Applicants respectfully request, therefore, that this rejection be withdrawn.

Rejections Under §102

The Action has rejected claims 36 and 39-42 over US Patent No. 5,980,694 (Apeldoorn). Applicants continue to traverse this rejection for reasons of record, and again state that not every element of the rejected claims is described in the Apeldoorn reference. The rejections under §102 are thus improper and should be withdrawn.

However, in order to progress the claims to allowance, or to present the claims in better condition for appeal, Applicants have offered an amendment to claim 36 that incorporates the elements of dependent claim 38, which is canceled herein. Claim 36 is thus even more clearly distinguished from the Apeldoorn disclosure.

Because claim 38 was not rejected under §102, the addition of the elements of claim 38 into independent claim 36 effectively removes the rejection of all claims over Apeldoorn, the only prior art rejection of record. Because this amendment removes the prior art issue, it presents the claims in better condition for appeal, should an appeal be required. The amendment is thus proper under 37 CFR §1.116(b). The Examiner is respectfully requested to enter the amendment and to withdraw the rejections under §102.

Applicants submit that all the Examiner's concerns have been addressed and that the claims are in condition for allowance. Such favorable action is respectfully requested. If the

Examiner has any questions or comments that would help progress the present claims to allowance, a telephone call to the undersigned representative is earnestly solicited.

Respectfully submitted,



Timothy S. Corder
Reg. No. 38,414
Agent for Applicants

Vinson & Elkins L.L.P.
2300 First City Tower
1001 Fannin
Houston, Texas 77002-6760
512/542-8446

Date: October 9, 2003